

Doc Code: AP.PRE.REQ

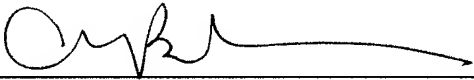
PTO/SB/33 (07-05)

Approved for use through 05/31/2008. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number	Filed
		10/700,406	November 4, 2003
		First Named Inventor	
		Matt MORANO	
		Art Unit	Examiner
		3692	Clement B. GRAHAM
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number _____ 35465 _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			



Signature

CAROL W. BURTON

Typed or printed name

303 454 2454

Telephone number

JUNE 25, 2008

Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	10/700,406	Customer No.	25235
Inventor(s):	Matt MORANO, et al.	Confirmation No.	5734
Filed:	November 4, 2003	Title:	DISTRIBUTED TRADING BUS ARCHITECTURE
TC/A.U.	3692		
Examiner:	Clement B. GRAHAM		
Docket No.	NYMX0002		

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

In response to the January 29, 2008 Final Office Action and the April 29, 2008 Advisory Action in this case, Applicant requests that the claim rejections be reviewed prior to the filing of an Appeal Brief for the reasons given below.

ISSUES FOR REVIEW

Applicant believes there are clear errors in the Examiner's rejections that should be reviewed. Such a review will show that the rejections are improper and without basis. The issues for review do not involve determining what the references teach or disclose, but rather whether the Examiner's conduct in citing the references and making the rejections, and also in reviewing and responding to the applicant's substantive arguments are improper under the Code of Federal Regulations and the M.P.E.P.

A. The Office Actions Fail to Properly Support a *Prima Facie* Obviousness Rejection Based on *Rosen*.

Pursuant to M.P.E.P. § 2142,

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness. . . .

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements. . .”

In the present case, the Examiner has repeatedly made only conclusory statements, as described below. The *Rosen* patent, the primary reference over which all claims are rejected, is a complex, 156 paragraph patent. Although the Examiner has incorporated a great deal of text in the Office Actions, the rejection of each claim element is merely a form paragraph assembled by the Examiner which cites the exact same 71 paragraphs of Rosen following each claim element copied verbatim.

Indeed, the following cite:

(see column 8 para 0065-0067 and para 0068-0074 and column 9-13 para 0089-0149)

appears 24 times in the final Office Action. See the following exemplary rejections:

As per claim 5, Rosen discloses where the match engine is configured specifically for a particular class of futures contracts and receives validated order messages only when they related to the particular class of futures contracts. (see column 8, para 0065-007 and para 0068-0074 and column 9-13 para 0089-0149).

As per claim 6, Rosen discloses wherein the particular class of futures contracts comprise a contract cluster and wherein responsive to contract clusters being identified, requiring the match engine to consider two or more contracts simultaneously to determine matches. (see column 8, para 0065-007 and para 0068-0074 and column 9-13 para 0089-0149).

The italicized portions are direct copies of the claim language. The citations which follow are the same 71 paragraphs of *Rosen*.

Moreover, the Examiner’s conclusory language is incorrect. For example, nowhere does *Rosen* teach or suggest “a contract cluster” or “responsive to contract clusters being identified, requiring the match engine to consider two or more contracts simultaneously to determine matches”.

B. Obviousness Rejection Based on *Rosen* in view of *Martini* is Does not Meet the Requirements of 37 CFR 1.104(c)(2).

Pursuant to 37 CFR 1.104(c)(2), when a reference is complex,

. . . . the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Nowhere does the Examiner explain the pertinence of each reference. He only provides conclusory language that each claim element is present.

C. The Examiner Fails to Answer the Substance of Applicant's Traversals, as Required by M.P.E.P. § 707.07(f).

M.P.E.P. § 707.07(f) states clearly:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument **and answer the substance of it.**

In the Advisory Action, the Examiner states that "Applicant's arguments were addressed within the prior Office Action." There are no such comments regarding Applicant's traversal in the Final Office Action.

Indeed, Applicant's arguments could not possibly have been addressed in the Final Office Action, because the Final Office Action contained new grounds of rejection which the Applicant had not previously traversed. Clearly, the Examiner is inserting stock phrases regarding reconsideration in the Advisory Action whether or not they apply and he completely fails to answer the substance of Applicant's traversals.

So, for example, there has been no response to Applicant's traversals below:

. . . [there are] no teachings in *Rosen* wherein a RAV component implements processes for evaluating risk should an order be completed and preventing completion on an order in response to the RAV component identifying an unacceptable position . . . *Martin* also fails to teach or suggest these claimed features. The text at col. 13, lines 34-40 of *Martin* relied upon in the Office Action only teaches how a shares being traded are allocated (subject to rounding according to minimum lot size) among different portfolios, each portfolio having predetermined risk class limits. This is matching function, which is not what is claimed. The reference in the Office Action to *Martin* col. 22, lines 14-44, merely encompasses *Martin*'s claim 19 reciting the matching technique—allocation of a group of shares of stock among a plurality of portfolios each having previously assigned risk classes. Nowhere does *Martin* teach, either expressly or inherently, "preventing completion on an order in response to the RAV component identifying an unacceptable position".

Further, *Martin* also fails to teach that the "risk allocation value (RAV) component . . . implements processes for evaluating risk associated with an order, should that order be completed". This claimed feature reflects that claim 1 is directed to a "distributed trading system . . . under which a participant will buy and/or sell a futures contract." *Martin* does not have this same need for evaluating risk should an order be completed, as the examples in *Martin* relate to a specified class of financial instruments—shares of stock. . . .

More particularly, in *Martin*, a computer system includes a first database that stores data associating securities portfolios with risk classes. *Martin* at col. 1, lines 48-50. A separate order management system sends messages about financial instruments such as shares of stocks grouped as a lot to be traded. . . . *Martin* fails to teach that it is these risk allocation processes themselves which implement processing which evaluate risk associated with an order, should that order be completed. Rather, *Martin* teaches that the order management system identifies a share lot available for trade and the allocation system finds portfolios who risk class can accept the available share lots given the risk classes previously assigned to the portfolios. There is no indication that *Martin* is evaluating risk, should an order be completed with an unacceptable risk, as is claimed.

When trying to understand the Examiner's position as to the obviousness rejection of claim 15, all 71 paragraphs were reviewed for any mention of "contract clusters". No mention of contract was found. The term "cluster" was found in a completely irrelevant context.

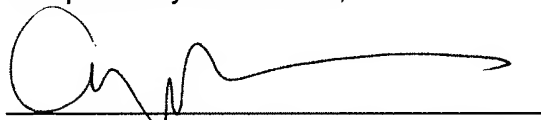
[with regard to claim 13] . . . the term "futures contract" does not appear anywhere in *Rosen*, despite the Office Action concluding, without any basis (except for the 71 paragraph reference), that "*Rosen* discloses a method . . . under which a participant will buy and/or sell a futures contract".

There is no attempt in any of the Office Actions to answer the substance of any of the above traversals.

B. Conclusion.

Not only does the conclusory language in the Office Actions fail to support a *prima facie* obviousness rejection of the pending claims, if Applicant's traversals had actually been considered, it would be clear that *prima facie* obviousness has not been established, as all of the claimed elements are not present in the combination of references. Thus, proper consideration of Applicant's responses and allowance of pending claims 1-25 are respectfully requested. Please charge Deposit Account No. 50-1123 any fees associated with this filing.

Respectfully submitted,



June 25, 2008

Carol W. Burton, Reg. No. 35,465
Hogan & Hartson L.L.P.
1200 17th Street, Suite 1500
Denver, Colorado 80202
Telephone: (303) 454-2454
Facsimile: (303) 899-7333